

ESTTA Tracking number: **ESTTA669321**Filing date: **04/29/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	EDWARD T. RILEY JR.		
Entity	Individual	Citizenship	UNITED STATES
Address	1770 BRAMBLE BUSH WAY SUWANEE, GA 30024 UNITED STATES		

Correspondence information	DARREN K. HASTINGS, ESQ. 6625 RUBY JUNE LANE CORYTON, TN 37721 UNITED STATES DARREN.HASTINGS@TRX.GLOBAL Phone:8652534836
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**Registration Subject to Cancellation**

Registration No	4140301	Registration date	05/08/2012
Registrant	Hannibal, Chauncey, A 5419 Hollywood Blvd. Ste c234 Hollywood, CA 90027 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 009. First Use: 1992/12/09 First Use In Commerce: 1992/12/09

All goods and services in the class are cancelled, namely: Apparatus for broadcasting, recording, transmission or reproduction of sound or images; Apparatus for recording and reproduction of sound, images or data; Apparatus for recording, transmission and reproduction of images; Apparatus for recording, transmission or reproduction of sound; Apparatus for recording, transmission or reproduction of sound and images; Apparatus for recording, transmission, processing and reproduction of sound, images or data; Apparatus for recording, transmitting and reproducing sound and images; Apparatus for speech recording and replaying; Apparatus for the recording, transmission and reproduction of sound and images; Audio and video cassette recorders; Audio and video recordings featuring music and artistic performances; Audio and video recordings featuring Blackstreet; Audio cassette recorders; Audio recorders; Audio recordings featuring Blackstreet; Audio speakers that may be attached with adhesive to the abdominal area of pregnant women for the purpose of transmitting music/sounds to the fetus, not for medical purposes; Audio tape recorders; Audio tapes featuring music; Blank CD-ROMs for sound or video recording; Blank integrated circuit cards for recording, transmitting, and reproducing sound and images in mobile telephone services; Cases for music, audio and related electronic equipment, namely, cases for audio tuners, audio receivers, amplifiers, tape players, compact disc players, MP3 controllers/players, audio mixers, audio speakers in the nature of music studio monitors, microphones, audio speakers, compact discs, audio tapes, portable computers, antennas, phonographic record players, audio recording equipment, and the cables associated with all of the foregoing equipment; Cassette recorders; Children's educational music CDs and DVDs; Compact disc players; Compact discs featuring music; Computer operating programs, recorded; Computer operating recorded programs; Computer programs for processing digital music files; Computer programs recorded on data media (software) designed for use in construction and automated manufacturing (cad/cam); Computer software featuring musical sound recordings and musical video recordings;

Computersoftware for creating and editing musicand sounds; Computer software for processing digital music files; Digital media, namely, pre-recorded DVDs, downloadable audio and video recordings, and CDs featuring and promoting Blackstreet; Digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definitiondigital discs featuring Blackstreet; Digital media, namely, music and videos featuring Blackstreet; downloadable ring tones via the Internet and wireless devices featuring music from Blackstreet; Digital photo frames for displaying digitalpictures, video clips and music; Downloadable computer software for use in recording music; Downloadable films and movies featuring Blackstreet provided via a video-on-demand service; Downloadable films and television programs featuring Blackstreet provided via a video-on-demandservice; Downloadable MP3 files and MP3recordings featuring Blackstreet; Downloadable MP3 files, MP3 recordings, on-line discussion boards, webcasts, webinarsand podcasts featuring music, audio books in the field of Blackstreet, and newsbroadcasts; Downloadable musical sound recordings; Downloadable ring tones, graphics and music via a global computer network and wireless devices; Downloadablevideo recordings featuring Blackstreet;Downloadable music via the internet andwireless devices; DVD recording apparatus; Home theater systems comprising DVD players; Juke boxes; Music recordings sold as a kit with a mask; Musical recordings; Musical sound recordings; Musical video recordings; Phonograph records featuring music; Plastic and cardboard casesfor storing record albums; Pre-recordedCDs featuring Blackstreet; Pre-recordedCDs, video tapes, laser disks and DVDs featuring Blackstreet; Pre-recorded digital media featuring Blackstreet; Pre-recorded digital video discs featuring Blackstreet; Pre-recorded DVDs featuring Blackstreet; Pre-recorded electronic and digital media featuring Blackstreet; Pre-recorded electronic media featuring Blackstreet; Pre-recorded flash drives featuring Blackstreet; Pre-recorded video discs, video recording and video tapes featuring Blackstreet; Prerecorded audio tapes featuring music; Prerecorded video cassettes featuring music; Prerecorded video tapes featuring music; Series of musical sound recordings; Sound recordings featuring Blackstreet; Video recordings featuring Blackstreet; Visual recordings and audiovisual recordings featuring music and animation; Wireless communication device featuring voice, data and image transmission including voice, text and picture messaging, a video and still imagecamera, also functional to purchase music, games, video and software applications over the air for downloading to the device

## Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Common Law Prior First Use in Commerce

Related Proceedings	CANCELLATION NUMBER 92059057
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## Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2075927	Application Date	12/09/1992
Registration Date	07/01/1997	Foreign Priority Date	NONE
Word Mark	BLACKSTREET		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1992/03/00 First Use In Commerce: 1992/03/00 entertainment services in the nature ofinstrumental and vocal group		

Attachments	CancellationPetition.pdf(132578 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/dkh/
Name	DARREN K. HASTINGS, ESQ.
Date	04/29/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the matter of Trademark Registration Number 4140301  
For the mark “BLACKSTREET”**

<b>EDWARD T. RILEY, JR.,</b>	)
<b>Petitioner,</b>	)
	)
<b>v.</b>	)
	)
<b>CHAUNCEY A. HANNIBAL,</b>	)
<b>Registrant.</b>	)

**PETITIONER’S STATEMENT OF GROUNDS FOR CANCELLATION OF  
TRADEMARK REGISTRATION NUMBER 4140301**

COMES NOW THE PETITIONER, Edward T. Riley Jr., by and through counsel, and will show that he is entitled to relief in the form of cancellation of Trademark Registration Number 4140301 through the following:

1. Petitioner Riley previously filed for cancellation of Registration Number 3877629, which is currently pending cancellation in TTAB Proceeding Number 92059057 and concerns the same mark, *to wit*, “BLACKSTREET”.
2. Petitioner Riley hereby incorporates by reference the same standing and legal ground to petition to cancel Registration Number 4140301 as he has asserted with respect to his petition to cancel Registration Number 3877629 pursuant to Cancellation Number 92059057 (as enumerated in Petitioner’s Revised Amended Petition for Cancellation dated March 11, 2015).
3. For the avoidance of doubt, Petitioner Riley also has standing to petition to cancel Registration Number 4140301 as well because:
  - a) Petitioner Riley is the originator and creative genius behind the group bearing the same name as the mark in question, *to wit*, “BLACKSTREET”—an R&B male vocal group that has

performed and continues to perform musical compositions that were primarily written, arranged, and produced by Petitioner Riley in 1991 and beyond;

- b) Petitioner Riley has at all times owned or co-owned all intellectual property associated with the BLACKSTREET mark, including all BLACKSTREET master recordings, which he continues to co-own with the co-founder of Interscope Records and the Chairman of Interscope Geffen A&M, Mr. Jimmy Iovine;
- c) Registrant Hannibal has never owned or co-owned any intellectual property associated with the BLACKSTREET mark;
- d) Petitioner Riley is the original and principal registrant of the BLACKSTREET trademark (Registration Number 2075927) and formed the associated corporate entity;
- e) At certain relevant times, Respondent Hannibal handled certain business aspects of the group BLACKSTREET and in this capacity received the renewal notification for Petitioner Riley's registration of the BLACKSTREET mark but failed to file the appropriate papers with the USPTO, which resulted in cancellation of Petitioner Riley's prior registration on April 4, 2008;
- f) Registrant Hannibal, well-aware of Petitioner Riley's prior first use, then subsequently filed his own trademark application for the BLACKSTREET mark in order to fraudulently convert assets and intellectual property belonging to Petitioner Riley, and in order to frustrate Petitioner Riley's ability to exercise his common law right to exploit intellectual property he owns or co-owns that is associated with the BLACKSTREET mark; AND
- g) Petitioner Riley has been, and continues to be, damaged by this registration insofar as Registrant Hannibal, through civil injunctions, cease and desist letters, threats of civil action, and the like, has prevented Petitioner Riley from exploiting intellectual property he owns or co-owns that is associated with the BLACKSTREET mark.

4. For the avoidance of doubt, Petitioner Riley has legal ground to petition to cancel Registration Number 4140301 because he has priority of use in that he first used the associated BLACKSTREET mark in commerce, *to wit*, in the United States and throughout the world, beginning on or about March 1992; he has since that time continued to use the mark in the advertisement and execution of public performances, and the exploitation of intellectual property he owns or co-owns that is associated with the BLACKSTREET mark, including master recordings; and his mark, as applied to his identified services, so resembles Registrant Hannibal's mark that there is a likelihood that the marks will result in confusion, mistake, and/or deception in commerce.

Further to this:

- a) Petitioner Riley has priority of use in the mark in that he is the originator and creative genius behind the group bearing the same name as the mark in question, *to wit*, "BLACKSTREET".
- b) Petitioner Riley has priority of use in the mark in that he first filed for registration of the mark on December 9, 1992, which is, notably, the date that Registrant Hannibal fraudulently asserted in his registration filing as his date of first use in commerce, and which is also notably still junior to Petitioner Riley's assertion of first use of the mark in March 1992, as evidenced by the filing associated with Registration Number 2075927.
- c) Despite publication for opposition on December 7, 1993, Registrant Hannibal did not oppose Petitioner Riley's December 7, 1992, filing on the mark.
- d) Petitioner Riley has priority of use of the mark in that the mark was first registered to him on July 1, 1997 (Registration Number 2075927) through its cancellation date of April 4, 2008, such cancellation which Petitioner will show is due to the fault and willful negligence of Registrant Hannibal.

e) As for the resemblance of Petitioner Riley's mark when compared to Registrant Hannibal's mark; they are the same mark, *to wit*, "BLACKSTREET". Thus, confusion, mistake, and/or deception are likely, and in fact most certain, in that such situations have *already* occurred in commerce with respect to the mark as both Petitioner Riley and Registrant Hannibal have concurrently used the mark in the advertisement and execution of public performances worldwide, while Petitioner Riley has also continued to attempt to exercise his common law right to exploit intellectual property he owns or co-owns that is associated with the BLACKSTREET mark, including the master recordings.

Respectfully submitted,

/dkh/

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Darren Hastings (Tennessee Bar No. 025439)  
*Attorney for Petitioner*